

REMARKS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

Claims 17, 50 and 51 are amended. Claims 6, 10, 13-14, 16, 19-22, and 24-29 have been withdrawn from consideration as being directed to a non-elected invention. After entry of this amendment, claims 17, 23, 50 and 51 will remain pending in the patent application.

Entry of the Amendment is proper under 37 C.F.R. §1.116 as the amendments:

(a) place the application in condition for allowance for the reasons discussed herein; (b) do not present any new issues that would require further consideration and/or search as the amendments merely amplify issues discussed throughout the prosecution; (c) do not present any additional claims without canceling a corresponding number of claims; and (d) place the application in better form for appeal, should an appeal be necessary. Entry of the Amendment is thus respectfully requested.

The amendment to the specification filed on October 24, 2003, was objected to under 35 U.S.C. §132. In connection with the objection, the Office Action alleges that the amendment introduces new matter because the added material (*i.e.*  $T \geq \pi (R^2L - r^2l)/4Q$ ) is allegedly not supported by the original disclosure. In response, Applicants note that the present application claims priority to Japanese application JP 2000-100418 filed on April 3, 2000, the content of which is incorporated in the present application by reference. A translation of JP 2000-100418 is enclosed herein. Applicants also note that the claim for priority to this Japanese application was acknowledged by the Office in confirmation receipt No. 3958, dated June 26, 2001. As can be seen on pages 1, 4, and 6 of this Japanese application, the relationship between  $T$  and  $\pi (R^2L - r^2l)/4Q$  is clearly indicated as  $T \geq \pi (R^2L - r^2l)/4Q$ . As mentioned in the October 24<sup>th</sup> Amendment, it is respectfully submitted that the relationship in paragraph [00171] was incorrectly indicated as  $T = \pi (R^2L - r^2l)/4Q$ , when it should have been  $T \geq \pi (R^2L - r^2l)/4Q$ . Moreover, as stated in the specification (p.34, lines 16-22) the time  $T$  represents a minimum time, the heating zone “is maintained at the sintering temperature” after reaching that temperature. Therefore, Applicants respectfully submit that no new matter has been added and respectfully request entry of the October 24<sup>th</sup> amendment to paragraph [00171]. Accordingly, reconsideration and withdrawal of the objection to the specification are respectfully requested.

Claims 17, 23 and 50-51 were rejected under 35 U.S.C. §112, second paragraph. Applicants respectfully submit that the amendment to claims 17 and 50 obviates the rejection.

With respect to claim 17, the language “which the base material is deposited” has been deleted and the step of “depositing glass particles on the bar material for producing the base material” has been added. It is respectfully submitted that the changes to claim 17 obviate the rejection and that no new matter has been added. A basis for the amendment to claim 17 may be found, for example, on page 9, lines 20-23 in the specification. Claims 23 and 51 are patentable by virtue of their dependency from claim 17.

With respect to claims 50-51, the language “the holding member” has been deleted and replaced by the language “the swing suppression mechanism” in claim 50 in order to obviate the rejection. Claim 51 is patentable by virtue of its dependency from claim 50.

Accordingly, reconsideration and withdrawal of the rejection of claims 17, 23, 50 and 51 under 35 U.S.C. §112, second paragraph are respectfully requested.

Claims 50-51 were rejected under 35 U.S.C. §112, first paragraph. Applicants respectfully submit that the amendment to claim 50 obviates the rejection. As mentioned in the foregoing discussion related to claim 50, the language “the holding member” has been deleted. Claim 51 is patentable by virtue of its dependency from claim 50. Accordingly, reconsideration and withdrawal of the rejection of claims 50-51 under 35 U.S.C. §112, first paragraph are respectfully requested.

Claim 17 was rejected under 35 U.S.C. §102(b) based on Tsuchiya et al. (U.S. Pat. No. 5,624,474) (Tsuchiya). The rejection is respectfully traversed.

Claim 17 recites a method for manufacturing a base material for an optical fiber, comprising holding a bar material by a support member constituted as one unit; making a swing suppressing mechanism contact with the support member in a perpendicular direction to the axis of the support member; rotating the bar material as a unit with the support member; and depositing glass particles on the bar material for producing the base material, wherein the swing suppression mechanism regulates a movement of the unit of the bar material and the support member, the movement being perpendicular to a direction of a rotation axis of the unit of the bar material and the support member.

In contrast to the method recited by claim 17, Tsuchiya discloses an optical fiber preform manufacturing apparatus including bearings (56 and 57) in contact with a rotating shaft 50. The shaft 50 is connected to a rod 38 through the chuck 36. Tsuchiya also discloses

that “the lower end of the rod 38 is connected to the upper end of a starting rod 44 serving as a starting point of growth of a preform 42.” (see col. 4, lines 23-25) However, Tsuchiya fails to teach or suggest a swing suppression mechanism that regulates a movement of the unit of the bar material and the support member, the movement being perpendicular to a direction of a rotation axis of the unit of the bar material and the support member. Tsuchiya only teaches that the rotary chuck is firmly supported so that the rotating shaft is not inclined. (see Abstract lines 13-14). Tsuchiya is however silent about the possibility of using the bearings as a swing suppression mechanism to regulate a movement of the unit of the bar material and the support member. To the contrary, it is respectfully submitted that the mechanism disclosed in Tsuchiya teaches away from such a possibility as “the starting rod 44 is suspended by the rod 38”. (see col. 4, lines 26-27) In other words, the arrangement described in Tsuchiya clearly enables the starting rod 44 to move freely with respect to the rod 38 and shaft 50. (see definition of the verb “to suspend” in Merriam-Webster’s Collegiate Dictionary Tenth Edition: “to hang so as to be free on all sides except at the point of support”) In Tsuchiya, the point of support of the starting rod is the lower end of rod 38. Therefore, it is respectfully submitted that the starting rod 44 can be moved freely with respect to shaft 50 (please also note that rod 38 is also suspended by shaft 50 with chuck 36, see col. 4, line 21). For that reason, it is respectfully submitted that bearings 56/57 of Tsuchiya cannot be configured to regulate a movement of the unit of the bar material and the support member, the movement being perpendicular to a direction of a rotation axis of the unit of the bar material and the support member. It should be noted that the ability to regulate the movement of the unit as claimed in the invention of claim 17 allows for producing a base material having a better concentric shape.

Accordingly, reconsideration and withdrawal of the rejection of claim 17 under 35 U.S.C. §102(b) based on Tsuchiya are respectfully requested.

Claim 23 was rejected under §103(a) based on Tsuchiya. The rejection is respectfully traversed.


Claim 23 depends from claim 17 and is patentable over Tsuchiya for the same reasons provided above related to claim 17. Namely, as Tsuchiya does not teach or suggest each and every feature recited by claim 23 (see foregoing discussion), Tsuchiya cannot render obvious claim 23.

Accordingly, reconsideration and withdrawal of the rejection of claim 23 are respectfully requested.

In view of the foregoing, the claims are now believed to be in form for allowance, and such action is hereby solicited. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,  
Pillsbury Winthrop LLP

By:   
Robert C. Perez  
Reg. No.: 39,328  
Tel. No.: (703) 905-2159  
Fax No.: (703) 905-2500

RCP/CFL  
Enclosure: copy of JP 2000-100418